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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,467	12/06/2003	Tariq M. Malik	920036-94963	1256

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EXAMINER
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RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/729,467

Applicant(s)

MALIK ET AL.

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to a membrane, classified in class 442, subclass 20.
  - II. Claim 16, drawn to a method of using said membrane, classified in class 52, subclass 408.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used in a different process for using that product, i.e. by using the membrane in a flooring system.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Glenn Ohlson on April 21, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 7, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0161615) in view of Hageman (US 2004/0261347). Cohen et al. disclose a facing material used in insulation which includes a sheet of aluminum foil, a polyester film, a non-woven fiberglass layer, and an extrusion that may be formed of a low-density polyethylene [0012]. The LDPE extrusion is used to bond the layers together, as well as to provide additional strength, rigidity, and conformability to the structure of facing [0036]. As seen in Figure 1B, an aluminum foil layer (shown at reference point 24) is laminated between polyester layers (shown at reference point 19 and 26). Cohen et al. disclose the claimed invention except for the teaching that the aluminum sheet is laminated to at least one fabric sheet impregnated with asphalt.

Hageman (US 2004/0261347) disclose a base sheet for a roof which includes a laminate of a metal layer, a plastic layer, and a core layer made of a fabric. The metal layer is an aluminum

and the plastic sheet is made of a polyester (abstract). The invention further comprises a built up roof composite formed of alternate layers of bituminous material and felt; the felts may be fiberglass or asphalt saturated felt [0032]. It would have been obvious to one having ordinary skill in the art to have used Hageman's asphalt saturated felt layer on the facing material of Cohen et al., motivated by the desire to create a material having increased fire resistance.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0161615) and Hageman (US 2004/0261347) as applied to claim 1 above, and further in view of Consentino (US 2004/0097157). Cohen et al. and Hageman disclose the claimed invention except for the teaching that one of the fabrics is a fiberglass scrim impregnated with asphalt.

Consentino (US 2004/0097157) disclose an insulation facing material comprising PET film [0032], aluminum metal layer [0060], and a glass scrim [0051]. It would have been obvious to one having ordinary skill in the art to have used Consentino's glass scrim in place of the nonwoven fiberglass layer of Cohen et al. and Hageman, motivated by the desire to create a facing material that is lightweight.

9. Claims 9-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0161615) and Hageman (US 2004/0261347) as applied to claims 1-8, 10, and 14 above, and further in view of Lynn et al. (US 6,093,481). Cohen et al. and Hageman disclose the claimed invention except for the teaching that the polyester sheets are polyethylene terephthalate and that the membrane is treated with an adhesion promoter comprising either an acrylic coating or a corona surface treatment.

Lynn et al. (US 6,093,481) disclose insulating sheathing materials with three-ply facers. The facer material comprises polyethylene terephthalate film (col 5, ln 20), aluminum foil metallic sheets (col 5, ln 25) and a fibrous sheet material (col 5, ln 27). The fibers may be a glass fiber sheet (col 4, ln 58-63). The attachment of the facing sheets may be facilitated by adhesion promoters or any fastening material. The adhesive may be an acrylic polymer (col 4, ln 9-22) and one or both sides of the polymeric material may be corona treated for enhanced adhesion (col 4, ln 44-45).

It would have been obvious to one having ordinary skill in the art to have used Lynn's PET film sheets as the polyester material in the laminate of Cohen et al. and Hageman, motivated by the desire to create a facer material that has the desired properties associated with the use of polyethylene terephthalate. Furthermore, it would have been obvious to have used the acrylic adhesive and corona treatment disclosed in Lynn, on the facer material of Cohen et al. and Hageman, motivated by the desire to create a facer material that has strong lamination strength.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR

*UCR*

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**Ula C. Ruddock**  
Primary Examiner  
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